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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,131	11/02/2006	Toshiyasu Sugio	2006_1794A	3938

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WENDEROTH, LIND & PONACK L.L.P.  
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Washington, DC 20005-1503

EXAMINER
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CHOWDHURY, NIGAR

ART UNIT	PAPER NUMBER
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2484

NOTIFICATION DATE	DELIVERY MODE
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06/10/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/565,131	<b>Applicant(s)</b> SUGIO ET AL.	
	<b>Examiner</b> NIGAR CHOWDHURY	<b>Art Unit</b> 2484	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-11,14-17 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,12,13 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-11,14-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/02/2006,12/10/2009,02/14/2011</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of claims 1-5, 8-11, 14-17, 19-23 in the reply filed on 03/31/2011 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5, 8, 10-11, 16, 19, 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0129385 by Speasl et al.

2. Regarding **claim 1**, a recording/reproduction terminal (host device) to which an encoding or decoding device (removable storage device) is detachably connected and which records or reproduces a signal representing audio or video, said recording/reproduction terminal comprising:

- a terminal information storage unit operable to store terminal information which is information regarding a recording/reproduction ability of the

recording/reproduction terminal (paragraph 0027 teaches "metadata" refers as a "terminal information" of incoming data files in order to identify incoming data file formats), and to output the terminal information to the encoding or decoding device when the encoding or decoding device is connected to said recording/reproduction terminal (paragraph 0042 teaches while the host device is connected to the storage device, the storage device receives an image file in a first format from the host device); and

- a signal transmission unit operable to transmit, to the encoding or decoding device, the signal representing audio or video to be encoded, when the signal representing audio or video is recorded (paragraph 0044 teaches incoming images is converts to a format to be stored into the memory 212 of storage device.).

3. Regarding **claim 2**, the recording/reproduction terminal further comprising storing encoded data obtained by encoding the signal representing audio or video into the encoding or decoding device (paragraph 0027, 0044 teaches incoming images is converts to a format to be stored into the memory 212 of storage device.).

4. Regarding **claim 3**, the recording/reproduction terminal

- wherein the terminal information (paragraph 0050 teaches "unique identification data") includes information which indicates existence of a

built-in encoding or decoding device built in said recording/reproduction terminal (paragraph 0042 teaches while the host device is connected to the storage device, the storage device receives an image file in a first format from the host device; wherein host device converts images into first format using built-in encoding or decoding device.),

- said recording/reproduction terminal making the encoding or decoding device encode the signal including audio or video, when the built-in encoding or decoding device does not exist (paragraph 0042 teaches while the host device is connected to the storage device, the storage device receives an image file in a first format from the host device; paragraph 0044 teaches incoming images is converts to a different format to be stored into the memory 212 of storage device while host device and storage is connected to each other).

5. Regarding **claim 4**, the recording/reproduction terminal comprising a reproduction unit operable to receive, from the encoding or decoding device, the signal representing audio or video which is obtained by decoding the encoded data stored in the encoding or decoding device by the encoding or decoding device, and to reproduce the signal, when the built-in encoding or decoding device does not exist (paragraph 0037, 0047, 0049-0050).

6. Regarding **claim 5**, the recording/reproduction terminal

- wherein the terminal information includes coding format information which indicates a coding format used by the built-in encoding or decoding device, said recording/reproduction terminal (paragraph 0037, 0047, 0049-0050) further comprising
- a built-in encoding or decoding device which encodes or decodes the signal representing audio or video using a predetermined coding format (paragraph 0037, 0047, 0049-0050),
- wherein said reproduction unit is operable to receive the signal including audio or video which is decoded by the encoding or decoding device, and to reproduce the signal when a coding format of the encoded data stored in the encoding or decoding device is different from the coding format indicated in the coding format information (paragraph 0037, 0047, 0049-0050), and
- said built-in encoding or decoding device is operable to receive the encoded data without decoding the encoded data, and decode the data when the coding format of the encoded data stored in the encoding or decoding device is the same as the coding format indicated in the coding format information (paragraph 0037, 0047, 0049-0050).

7. Regarding **claim 8**, the recording/reproduction terminal further comprising:

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- a memory operable to provide a working area for encoding or decoding processing performed by the encoding or decoding device (fig. 1, 2, paragraph 0021);
- a memory use request receiving unit operable to receive a use request for said memory from the encoding or decoding device (paragraph 0037, 0044); and
- a memory control unit operable to make the encoding or decoding device use a part or all of the area in said memory when the use request is received (paragraph 0037, 0044).

8. **Claim 10** is rejected for the same reason as discussed in the corresponding claim 1 above.

9. **Claim 11** is rejected for the same reason as discussed in the corresponding claim 2 above.

10. Regarding **claim 16**, the encoding or decoding device further comprising a signal receiving unit operable to receive, from the recording/reproduction terminal, a signal to be stored into said encoded data storage unit wherein said encoding or decoding unit is operable to store the received signal without coding the received signal, when the signal is encoded data (paragraph 0027, 0028, 0044).

11. **Claim 19** is rejected for the same reason as discussed in the corresponding claim 2 above.
12. **Claim 22** is rejected for the same reason as discussed in the corresponding claim 1 above.
13. **Claim 23** is rejected for the same reason as discussed in the corresponding claim 1 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 9, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0129385 by Speas et al. In view of US 7,606,871 by Kawamoto et al.
15. Regarding **claim 9**, Speas et al. discloses a terminal information storage unit operable to store terminal information which is information regarding a recording/reproduction ability of the recording/reproduction terminal (paragraph 0027 teaches "metadata" refers as a "terminal information" of incoming data files in order to identify incoming data file formats) but fails to disclose the recording/reproduction terminal wherein the terminal information includes memory information which indicates an available capacity of said memory in said recording/reproduction terminal, said



recording/reproduction terminal further comprises an available capacity detection unit operable to regularly detect the available capacity of said memory, and said memory control unit is operable to update the memory information in the terminal information with a value of the newly detected available capacity.

Kawamoto et al. discloses the recording/reproduction terminal wherein the terminal information includes memory information which indicates an available capacity of said memory in said recording/reproduction terminal, said recording/reproduction terminal further comprises an available capacity detection unit operable to regularly detect the available capacity of said memory, and said memory control unit is operable to update the memory information in the terminal information with a value of the newly detected available capacity (claim 2, 5).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Speasl et al.'s system to include memory information, as taught by Kawamoto et al., for controlling the storage capacity of the memory for a user to have an opportunity to store more information based on available capacity.

16. **Claim 20** is rejected for the same reason as discussed in the corresponding claim 9 above.

17. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0129385 by Speasl et al. In view of US 7,180,606 by Mahon et al.

18. Regarding **claim 14**, Speasl et al. discloses a terminal information storage unit operable to store terminal information which is information regarding a recording/reproduction ability of the recording/reproduction terminal (paragraph 0027 teaches "metadata" refers as a "terminal information" of incoming data files in order to identify incoming data file formats) but fails to disclose the encoding or decoding device wherein the terminal information includes information which indicates a maximum data transfer amount per unit time between the recording/reproduction terminal and said encoding or decoding device, and said encoding or decoding unit is operable to convert, depending on the information indicating the maximum data transfer amount, at least one of a frame rate and resolution of a decoded moving picture signal so that a data amount per unit time of the moving picture signal does not exceed the maximum data transfer amount, when the moving picture signal is decoded from the encoded data in said encoded data storage unit (fig. 3, col. 3 lines 24-40).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Speasl et al.'s system to include maximum data transfer amount, as taught by Mahon et al., for controlling the output of the image based on frame rate or resolution and thus increasing the user friendliness to the system.

19. **Claim 15** is rejected for the same reason as discussed in the corresponding claim 14 above.

20. Claims 17, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0129385 by Speas et al. In view of US 6,215,560 by Shimura et al.

21. Regarding **claim 17**, Speas et al. discloses a terminal information storage unit operable to store terminal information which is information regarding a recording/reproduction ability of the recording/reproduction terminal (paragraph 0027 teaches "metadata" refers as a "terminal information" of incoming data files in order to identify incoming data file formats) but fails to disclose the encoding or decoding device wherein said encoding or decoding unit is operable to convert at least one of a frame rate and resolution of the moving picture signal depending on an available capacity of said encoded data storage unit when the signal including audio or video is the moving picture signal, and to encode the converted signal.

Shimura et al. discloses disclose the encoding or decoding device wherein said encoding or decoding unit is operable to convert at least one of a frame rate and resolution of the moving picture signal depending on an available capacity of said encoded data storage unit when the signal including audio or video is the moving picture signal, and to encode the converted signal (fig. 3 (s303), col. 3 lines 22-35).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Speas et al.'s system to include available capacity, as taught by Shimura et al., for controlling the storage capacity of the memory for a user to have an opportunity to store more information by converting resolution.

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22. **Claim 21** is rejected for the same reason as discussed in the corresponding claim 17 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 2484